REMARKS

Reconsideration of the pending application is respectfully requested on the basis of the following particulars.

1. In the claims

As shown in the foregoing AMENDMENT TO THE CLAIMS, the claims have been amended to more clearly point out the subject matter for which protection is sought.

A. Claim amendments

Claims 1, 2, and 4 are amended to correct minor informalities pointed out in the Office action. Specifically, the language "is (are) configured to" is provided in place of the word "can." Further, the limitation "such as steel" has been removed from claim 1. It is respectfully submitted that no new matter is added as the changes merely correct minor informalities pointed out in the Office action.

Claim 3 is left unchanged.

Entry of the AMENDMENT TO THE CLAIMS is respectfully requested in the next Office communication.

B. Claim objections

Reconsideration and removal of the claim objections is respectfully requested, on the basis that the amendments to the claims overcomes the objections.

As discussed in the previous section, claims 1, 2, and 4 are amended to recite that features are configured to have particular structure, in compliance with the suggested language of the Office action. Further, the range within a range of original claim 1 has been removed by the removal of the limitation "such as steel."

Accordingly, removal of the claim objections is respectfully requested.

2. Rejection of claim 1 under 35 U.S.C. § 103(a) as being unpatentable over U.S. patent no. 4,110,003 (*Zinn*) in view of U.S. patent no. 5,128,644 (*Nellessen*) and further in view of U.S. patent no. 6,470,950 (*Shimizu*)

Reconsideration of this rejection is respectfully requested on the basis that the rejection fails to establish a *prima facie* case of obviousness with respect to claim 1.

A. The cited references do not disclose or suggest every claimed limitation

Reconsideration of this rejection is respectfully requested on the basis that the rejection fails to establish a *prima facie* case of obviousness with respect to claim 1 because the cited publications fail to disclose or suggest every limitation of pending claim 1.

The shortcomings of each patent will be discussed individually followed by a discussion of the deficiencies of the proposed combination of the patents.

i. The *Zinn* patent

The *Zinn* patent fails to disclose a screen attached between upper and lower rods and configured to be rolled up by the lower rod, groove shaped rings processed with a magnetic material attached to left and right ends of the upper rod, and magnets coupled on left and right ends of the lower rod, all as required by pending claim 1.

The embodiment of pending claim 1 provides a wall roll-up screen including an upper rod and a lower rod. The screen is configured to be rolled up by the lower rod, which has magnets coupled to the left and right ends of the lower rod. The upper rod includes groove shaped rings of magnetic material on the right and left ends that couple with the magnets on the lower rod when the screen is rolled up.

Thus, the screen can be unrolled or rolled up around the lower screen rod under an applied force by the user. When no force is applied by the user, the rotation of the lower rod is stopped or attenuated by the cooperation of the magnetic force of the magnets and the groove shaped rings processed with magnetic material. Therefore, the rotation of the lower rod is carried out in a smooth manner due to the

attenuation provided by the magnets and the groove shaped rings. Further, when the screen is completely rolled up on the lower rod, the magnets are coupled with the groove shaped rings in order to prevent the accidental unrolling of the screen. Thus, the embodiment of claim 1 provides a wall roll-up screen that can be used semi-permanently without any trouble, and yet is conveniently portable due to the simplified structure and reduced weight and volume of the wall roll-up screen of the embodiment of claim 1.

In contrast, the *Zinn* patent discloses a portable screen having a collapsible tensioning rod placed horizontally between a pair of hollow, elongate tube members that are attached to the short edges (right and left edges) of a screen to maintain the tubes in a spaced relationship and to tension the flexible screen (col. 1, lines 35-37, and 47-49; col. 3, lines 7-10). Thus, the *Zinn* patent discloses right and left hollow elongate tube members as opposed to the upper and lower rod members required by pending claim 1.

Further, the *Zinn* patent discloses end caps 37, 38 that fit over the tubes. The end caps of the *Zinn* patent are clearly not "groove shaped" as required by pending claim 1. At most, the end caps have a frusto-conical or tapered shape. While courts have held that a mere change in shape of an element, without more, may not be patentable, in the embodiment of pending claim 1 the groove shaped rings provide the important structure for couplingly receiving the magnets of the lower rod.

Further, as acknowledged in the Office action on pages 3 and 4, the *Zinn* patent fails to disclose that the groove shaped rings are processed with a magnetic material and that magnets are provided at the right and left ends of the lower rod.

Accordingly, the *Zinn* patent fails to disclose a screen attached between upper and lower rods, groove shaped rings processed with a magnetic material attached to left and right ends of the upper rod, and magnets coupled on left and right ends of the lower rod, all as required by pending claim 1.

ii. The *Nellessen* patent

The *Nellessen* patent is firstly non-analogous art. The *Nellessen* patent secondly fails to disclose a screen attached between upper and lower rods and configured to be rolled up by the lower rod, groove shaped rings processed with a magnetic material attached to left and right ends of the upper rod, and magnets coupled on left and right ends of the lower rod, all as required by pending claim 1.

The test for analogy has two prongs, either of which must be satisfied to show that references are analogous. *In re Wood*, 599 F.2d 1032, 1036, 202 USPQ 171, 174 (CCPA 1979). A determination must first be made whether the reference falls within the same field of endeavor as the claimed invention. *Id.* If it is determined that the reference is not within the same field of endeavor, then a determination must be made "whether the reference is reasonably pertinent to the particular problem with which the inventor was involved." *Id.*

The *Zinn* patent, as well as the embodiment of claim 1, are in the field of portable display screens. The problems associated with portable display screens are how to maintain the screen in either the open/unrolled or closed/rolled up position while maintaining the reduced size and weight required for a portable screen.

The *Nellessen* patent is in the field magnetic assemblies for retaining ferrous materials in the upper stomach of cows in order to prevent damage to the internal organs of the cow. There is absolutely no correlation between the field of portable display screens and the field of cow magnets. Further, the problems addressed by the *Nellessen* patent include reducing corrosion of the magnet in stomach acids and preventing sharp materials from attaching perpendicularly to the magnet.

It is clear that the *Zinn* patent and the embodiment of claim 1 are in the field of endeavor related to portable display screens. It is also clear that the *Nellessen* patent is in the field of endeavor related to cow magnets. Thus, the *Nellessen* patent clearly fails the first prong of the analogous art test.

As to the second prong of the analogous art test, while reduced corrosion resistance is a generally applicable problem to almost any field of endeavor, the particular problem of the *Zinn* patent and the embodiment of claim 1 is the problem of trying to provide both a lightweight portable display screen that has structure to maintain the screen in an open/unrolled or closed/rolled up position.

The particular problem that the *Nellessen* patent is involved with (aside from improving corrosion resistance) is to increase dramatically the structural integrity of the cow magnet.

It now becomes evident that these particular problems are not reasonably pertinent to each other, and thus, the *Nellessen* patent fails the second prong of the analogous art test.

Since the *Nellessen* patent does fail both prongs of the analogous art test, it simply cannot be considered analogous art, and is therefore unavailable as a reference under 35 U.S.C. § 103(a).

Further, while PTO classification may provide some evidence of analogy or nonanalogy, the courts have given far greater weight to the similarities and differences in structure and function. *In re Ellis*, 476 F.2d 1370, 1372, 177 USPQ 526, 527 (CCPA 1973). However, the *Nellessen* patent fails to satisfy either the PTO classification factor or the similar structure and function factor.

The *Zinn* patent and the embodiment of claim 1 both have a display screen connected at opposing ends to hollow tubes or rods. The cow magnet of the *Nellessen* patent is simply an assembly of a rod and a number of plates.

Thus, the *Nellessen* patent has a substantially different structure than the *Zinn* patent or the embodiment according to claim 1, and is nonanalogous art, and cannot be relied upon for the purposes of a rejection under 35 U.S.C. §103(a).

Even if the *Nellessen* patent were to be considered analogous art, the *Nellessen* patent fails to disclose a screen attached between upper and lower rods and configured to be rolled up by the lower rod, groove shaped rings processed with a magnetic

material attached to left and right ends of the upper rod, and magnets coupled on left and right ends of the lower rod, all as required by pending claim 1.

Instead the *Nellessen* patent discloses a cow magnet having a rod with steel and zinc plates and steel, zinc plated end caps 4. The end caps 4, along with the entire assembly, are magnetized once the assembly is complete (col. 4, lines 55-61). Thus, the *Nellessen* patent at most teaches a magnet having end caps. Due to the fact that the magnet of the *Nellessen* patent is to be ingested in the upper stomach of a cow, the magnet has a pill shape. Thus, as shown in Figs. 1-3, the end caps are hemispherical in shape.

Accordingly, the *Nellessen* patent is non-analogous art and also fails to disclose a screen attached between upper and lower rods and configured to be rolled up by the lower rod, groove shaped rings processed with a magnetic material attached to left and right ends of the upper rod, and magnets coupled on left and right ends of the lower rod, all as required by pending claim 1.

iii. The *Shimizu* patent

The *Shimizu* patent fails to disclose a screen attached between upper and lower rods and configured to be rolled up by the lower rod, groove shaped rings processed with a magnetic material attached to left and right ends of the upper rod, and magnets coupled on left and right ends of the lower rod, all as required by pending claim 1.

Instead, the *Shimizu* patent discloses an upper take-up roll 1 onto which a number of screens are rolled up and selectively unrolled to selectively display the desired screen (abstract; Fig. 1). A lower weight bar 30 is attached to the first screen 3 (col. 4, lines 11-12). The upper take-up roll 1 does not have groove shaped rings attached to the left and right ends of the roll and the weight bar 30 has no magnets coupled to the left and right ends of the bar.

Secondary screens 4 include a reinforcing bar 40 attached to the lower ends (col. 4, lines 12-13). In particular embodiments the secondary screens include magnetic engagement means 5a-c. One of the engagement means 5a is provided on

the reverse side of the first screen 3 and the other engagement means are provided on lower ends of the secondary screens (Figs. 1 and 2). In order to selectively display the desired screen, the engagement means of the screens that are not to be displayed cooperate with the engagement means 5a on the reverse side of the first screen 3 (col. 4, lines 40-45; col. 5, lines 29-67).

Thus the *Shimizu* patent discloses engagement means that are connected to the screens themselves rather than groove shaped rings attached to the left and right ends of the upper rod and magnets coupled to the left and right ends of the lower rod. Further, the *Shimizu* patent discloses the screens being rolled up onto the upper rod as opposed to the lower rod.

Accordingly, the *Shimizu* patent fails to disclose a screen attached between upper and lower rods and configured to be rolled up by the lower rod, groove shaped rings processed with a magnetic material attached to left and right ends of the upper rod, and magnets coupled on left and right ends of the lower rod, all as required by pending claim 1.

iv. The combination of the *Zinn*, *Nellessen*, and *Shimizu* patents

As discussed above with respect to each of the *Zinn*, *Nellessen*, and *Shimizu* patents, none of the cited patents discloses a screen attached between upper and lower rods and configured to be rolled up by the lower rod, groove shaped rings processed with a magnetic material attached to left and right ends of the upper rod, and magnets coupled on left and right ends of the lower rod, all as required by pending claim 1.

Therefore, the combination of the *Zinn*, *Nellessen*, and *Shimizu* patents also fails to disclose a screen attached between upper and lower rods and configured to be rolled up by the lower rod, groove shaped rings processed with a magnetic material attached to left and right ends of the upper rod, and magnets coupled on left and right ends of the lower rod, all as required by pending claim 1, since these features are not disclosed in any of the cited patents.

Accordingly, since none of the cited patents discloses a screen attached between upper and lower rods and configured to be rolled up by the lower rod, groove shaped rings processed with a magnetic material attached to left and right ends of the upper rod, and magnets coupled on left and right ends of the lower rod, all as required by pending claim 1, a *prima facie* case of obviousness cannot be maintained and withdrawal of this rejection is respectfully requested.

B. There is no motivation to combine the cited references

Reconsideration of this rejection is respectfully requested on the basis that the rejection fails to establish a *prima facie* case of obviousness with respect to claim 1 because there is no suggestion or motivation to combine the cited patents.

To begin, there is simply no suggestion within any of the cited patents that would have motivated a skilled artisan to provide the cow magnet of the *Nellessen* patent to the screen of the *Zinn* patent, since the *Nellessen* patent is non-analogous art. The supposed motivation of the Office action that the end caps 37, 38 of the *Zinn* patent would be "more durable during transport compared to plastic ones" simply has no factual basis.

Factual evidence is necessary for any rejection under 35 U.S.C. § 103(a) (*In re Lee*, 277 F.3d 1338, 1342-3 (Fed. Cir. 2002)). Here the rejection relies on an unsupported assertion that end caps processed with magnetic material are more durable than plastic end caps during transport, without any factual basis for the statement.

However, certain types of rare earth magnets are quite brittle, while a number of plastic materials are flexible and compliant. Thus, a valid assertion would be that plastic end caps would be more durable during transport than end caps processed with magnetic material. Thus, unless the Office can provide evidence supporting the assertion that end caps processed with magnetic material are more durable than plastic end caps during transport, there is simply no suggestion that would have motivated a skilled artisan to provide the cow magnet of the *Nellessen* patent to the screen of the *Zinn* patent.

Further, there is no suggestion that would have motivated a skilled artisan to provide the engaging features of *Shimizu* patent to the screen of the *Zinn* patent. As discussed above, the *Zinn* patent discloses a single screen having hollow tubes attached along the short sides of the screen, as opposed to the upper and lower sides of the screen. Further, as also discussed above, the *Shimizu* patent discloses multiple screens attached to an upper take-up roll, and selectively unrollable to display the desired screen. The engagement means of the *Shimizu* patent merely keep the unselected screens from unrolling.

Since the *Zinn* patent discloses only a single screen that unrolls horizontally, a skilled artisan would not have been motivated to provide the vertically rolling, multiple screen features of the *Shimizu* patent to the structure of the *Zinn* patent.

Thus, because a skilled artisan would not be motivated to combine the cited patents, a *prima facie* case of obviousness cannot be maintained, and withdrawal of this rejection is respectfully requested.

C. There is no reasonable expectation of success

Reconsideration of this rejection is respectfully requested on the basis that the rejection fails to establish a *prima facie* case of obviousness with respect to claim 1 because there is no reasonable expectation of successfully combining the cited patents.

Similarly to the discussion above, since the *Nellessen* patent is non-analogous art, there is no reasonable expectation that the cow magnet of the *Nellessen* patent may be successfully combined with the screen of the *Zinn* patent.

Further, since the screen of the *Zinn* patent is a single screen that rolls up horizontally, there is no reasonable expectation that the multiple, vertically rolling and unrolling screens of the *Shimizu* patent may be successfully combined with the screen of the *Zinn* patent.

Furthermore, even if the features of all of the *Zinn*, *Nellessen*, and *Shimizu* patents were to be combined, as discussed above, since none of the cited patents

discloses every feature of claim 1, there is no reasonable expectation that the combination of the *Zinn*, *Nellessen*, and *Shimizu* patents will successfully disclose every feature of pending claim 1.

Accordingly, since there is no reasonable expectation of successfully combining the *Zinn*, *Nellessen*, and *Shimizu* patents, a *prima facie* case of obviousness cannot be maintained and withdrawal of this rejection is respectfully requested.

3. Allowable subject matter

The applicant gratefully acknowledges the indication of allowable subject matter in claims 2-4. However, as discussed above, claim 1 is patentable on its own merits, without requiring the addition of allowable subject matter from claims 2-4.

4. Conclusion

As a result of the amendment to the claims, and further in view of the foregoing remarks, it is respectfully submitted that the application is in condition for allowance. Accordingly, it is respectfully requested that every pending claim in the present application be allowed and the application be passed to issue.

If any issues remain that may be resolved by a telephone or facsimile communication with the applicant's attorney, the examiner is invited to contact the undersigned at the numbers shown below.

BACON & THOMAS, PLLC
625 Slaters Lane, Fourth Floor
Alexandria, Virginia 22314-1176
Phone: (703) 683-0500
Facsimile: (703) 683-1080

Date: March 26, 2007

Respectfully submitted,

JUSTIN J. CASSELL
Attorney for Applicant
Registration No. 46,205